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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/515,717	02/29/00	NGUYEN B	IGT1P030/P-2

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EXAMINER	
SAGER, M	

ART UNIT	PAPER NUMBER
3713	5

DATE MAILED: 10/09/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.	Applicant(s)
09/515,717	Nguyen
Examiner	**Art Unit**
Sager	3713

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *three* MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on *Feb 29, 2000; Jan 12, 2001; April 9, 2001*.

2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) *1-40* is/are pending in the application.

4a) Of the above, claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) *1-40* is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

9) ☒ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.

12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

a) ☐ All b) ☐ Some* c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

MARK SAGER
PRIMARY EXAMINER

Attachment(s)

15) ☒ Notice of References Cited (PTO-892)
16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). *2-4*
18) ☐ Interview Summary (PTO-413) Paper No(s). _____
19) ☐ Notice of Informal Patent Application (PTO-152)
20) ☐ Other:

Specification

1. The following is a quotation of 37 CFR 1.71(a)-(c):

> (a) The specification must include a written description of the invention or discovery and of the manner and process of making and using the same, and is required to be in such full, clear, concise, and exact terms as to enable any person skilled in the art or science to which the invention or discovery appertains, or with which it is most nearly connected, to make and use the same.
> (b) The specification must set forth the precise invention for which a patent is solicited, in such manner as to distinguish it from other inventions and from what is old. It must describe completely a specific embodiment of the process, machine, manufacture, composition of matter or improvement invented, and must explain the mode of operation or principle whenever applicable. The best mode contemplated by the inventor of carrying out his invention must be set forth.
> © In the case of an improvement, the specification must particularly point out the part or parts of the process, machine, manufacture, or composition of matter to which the improvement relates, and the description should be confined to the specific improvement and to such parts as necessarily cooperate with it or as may be necessary to a complete understanding or description of it.

The specification is objected to under 37 CFR 1.71 because it fails to enable paper being a (electronic, magnetic) memory device (clm 28), as currently claimed. Conventionally, memory device is electronic, magnetic medium for storing data; however, there is no disclosed teaching how the display of prizes on a paper printout conforms to electronic, magnetic memory media. .

Claim Objections

2. Claims 8, 16, 20-23 and 34 are objected to because of the following informalities: use of acronyms since acronyms may change over time which may correspondingly change scope of invention (clms 8, 16, 20 and 34); while, claim 21 appears to be missing language 'more an outcomes' (line 12). Appropriate correction is required.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it

pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claim 28 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The disclosure fails to enable paper being a memory device (supra).

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claim 28 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. A paper printout is an output, but not a memory device as conventionally used and thus claim is confusing/inept for how paper is memory (electronic, magnetic) or possibly applicant has invented electronic fibers within pulp fibers for storing such data electronically, magnetically (supra)?

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless --
>
> (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
> (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who

> has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

8. Claims 1, 3-7, 9-12, 14, 17-22, 24-29, 31-36 and 38-39 are rejected under 35 U.S.C. 102(a) as being clearly anticipated by admitted prior art disclosed in instant background.

9. Claims 1, 3-12, 14, 16-18, 20-22 and 24-34 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Stupak et al (5851147).

10. Claims 1, 3-12, 14, 16-22, 24-26, 29-36 and 38-39 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Walker et al (6068552).

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

12. The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

13. Claims 2, 13, 15, 23 and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker et al (6068552) or over Walker ('552) in view of admitted prior art. Walker discloses a gaming devices and method teaching claimed features/steps including cash (supra)

except the alternate theme (clm 13) prizes (clms 2, 15, 23, and 37). Non-cash prizes, such as merchandise, vacations, airline miles or shopping sprees, are notoriously well known as theme prizes which are monetarily equivalent to cash prizes taught by Walker. Alternatively, Instant background provides admission that non-cash prizes are ~~as~~ payout 2:22-24 such that some players may be motivated to win cruises or automobiles (3:12-13). Therefore, it would have been obvious to an artisan at time prior to invention to add 'merchandise, vacations, airline miles, shopping sprees' and 'theme' as notoriously well known or as equivalent or as admitted prior art to Walker's game device and method to provide alternate equivalent payout or to motivate players by providing prizes of players' personal interest.

14. Claims 27-28, 30 and 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker et al (6068552) in view of Walker et al (6110041). Alternatively, where outputting prize is not awarding selected prize by transferring won cash credits to a memory device, Walker '552 discloses a game device and method comprising claimed steps/features (supra) including player tracking cards such as magnetic or smart card 4:13-24) for communicating player data such as player identification or credits except 'portable memory device' being a particular memory device (clm 27-28, 40) for receiving prize selection as claimed. Walker ('041) discloses a method and system for adapting/configuring gaming devices to player preferences teaching outputting prize selection to a 'portable memory device' particularly such as magnetic card or smart card (2:13-49; 3:28-9:44, esp. 9:36-44, figs. 1-11b, esp. Figs. 5 and 7) to automatically adapt/configure gaming device to player's preferences such as payout structure so as to maintain player interest which eliminates or reduces player wandering casino in search of preferred configured game (2:13-49

esp. 13-20). Therefore, it would have been obvious to an artisan at a time prior to the invention to add portable memory device such as magnetic or smart card as taught by Walker '041 to Walker's gaming device and method to automatically adapt/configure gaming device to player's preferences such as payout structure so as to maintain player interest which eliminates or reduces player wandering casino in search of preferred configured game (2:13-49 esp. 13-20).

Regarding claim 30, Walker ('552) teaches receiving a wager prior to receiving an input signal from prize selection mechanism between subsequent game sessions. Alternatively, where prize selection refers to player prize selection rather than default or casino selections, Walker ('041) discloses a method and system comprising teaching receiving a wager amount prior to receiving an input signal ~~form~~ from the [player] prize selection mechanism (7:39-9:44, figs. 1-11b, esp. 10a-11b) to stimulate players interest in continuing to play slot machine (9:1-7). Therefore, it would have been obvious to an artisan to add receiving a wager amount prior to receiving an input signal from the prize selection mechanism as taught by Walker ('041) to Walker's gaming device and method to stimulate players interest in continuing to play slot machine (9:1-7).

Conclusion

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to M. A. Sager whose telephone number is (703) 308-0785. The examiner can normally be reached on T-F from 0700 to 1700. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ms. Valencia Martin Wallace, can be reached on (703) 308-4119. The fax phone number for this Group is (703) 305-3580. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1148.

M. Sager
Primary Examiner
Sep. 22, 2001